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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,339	04/12/2001	Rabindranath Dutta	AUS920010216US1	3779
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/833,339	Applicant(s) DUTTA ET AL.	
	Examiner Timothy M. Harbeck	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 9-15, 17-19, 21-27, 29-31, 33-39, 41-43 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-15, 17-19, 21-27, 29-31, 33-39, 41-43 and 45-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/19/2005, 1/30/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-6, 13-15, 17-18, 25-27, 29-30, 37-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson et al (hereinafter Stinson; US PAT 6,786,398) in view of Anderson et al (hereinafter Anderson US PAT 6,021,202) in view of Zajkowski et al (hereinafter Zajkowski US PAT 6,705,517) in view of Rhoads (US 2001/0022848 A1).

Re Claim 1: Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising:

- Receiving a customer check issued by a customer at the automatic teller machine (Column 1, lines 58-61)
- Identifying an amount for the customer check (Column 1, lines 63-64)

Stinson does not explicitly disclose

- Creating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued and wherein funds for the amount are guaranteed by the financial institution

Anderson discloses a method and system for processing electronic documents wherein an electronic check is created at an ATM machine (Column 22, lines 63-67) and wherein the funds for the amount are guaranteed by a financial institution (Column 23, lines 5-11). While Anderson does not explicitly disclose printing the new check, it is old and well known to be able to print a hard copy version of an electronic document and furthermore, Zajkowski discloses that negotiable financial instruments like checks can be dispensed from automated banking machines (Column 1, lines 40-43). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Anderson and Zajkowski to the disclosure of Stinson so that a user could convert a first negotiable instrument into a second that is essentially a cash equivalent. A user may not want to simply cash the check for fear of losing a large sum of money, whereas with a check there is a higher degree of security should that instrument be lost or stolen. Furthermore, if the customer can print the new check as a hard copy form, it can be personally transferred to the appropriate recipient.

Finally Rhoads discloses the old and well known method of digital watermarking a security document such as negotiable financial instruments (page 1; paragraph 0008), wherein the security document (check) includes a digital water mark identifying a financial institution for an account on which the customer check is issued (page 2, paragraph 0019). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the digital watermarking procedures of Rhoads to the disclosure of Stinson / Anderson / Zajkowski to provided additional security measures to the check, including discouraging counterfeiting, transferring information through the

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documents without alerting human viewers to the presence of the information (Rhoads, paragraph 0008), or identifying a financial institution linked to the document (Rhoads, paragraph 0019).

Re Claim 2: Stinson in view of Anderson / Zajkowski / Rhoads discloses the claimed method supra and Anderson further discloses the step comprising verifying funds are available in the account on which the customer check is issued prior to creating the new printed certified check (Column 24, lines 29-37).

Re Claim 3: Stinson in view of Anderson / Zajkowski / Rhoads discloses the claimed method supra and Zajkowski further discloses dispensing the new printed certified check to the customer at the automatic teller machine (Column 41-44).

Re Claim 5 and 6: Stinson in view of Anderson / Zajkowski / Rhoads discloses the claimed method supra and Anderson further discloses wherein the new printed certified check is sent to the third party designated by the customer at the automated teller machine or as an electronic certified check (Column 23, lines 54-56). A user of the combined system would simply print the new certified check, then insert this new check into the ATM machine for processing and forwarding as either a paper check or an electronic check.

Re Claims 13-15 and 17-18: Further data processing system would have been necessary to perform previously rejected method claims 1-3 and 5-6 respectively and are therefore rejected using the same art and rationale.

Re Claims 25-27 and 29-30: Further data processing system would have been necessary to perform previously rejected method claims 1-3 and 5-6 respectively and are therefore rejected using the same art and rationale.

Re Claims 37-39 and 41-42: Further computer program product would have been necessary to run previously rejected method claims 1-3 and 5-6 respectively and are therefore rejected using the same art and rationale.

Claims 7, 19, 31 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Rhoads.

Re Claim 7: Stinson discloses a method for processing checks comprising:

- Receiving a check from a customer at the automatic teller machine
(Column 1, lines 58-61)

Stinson does not explicitly disclose the steps of

- Scanning a check to create an image of the check
- Searching the image of the check for an overlaid digital watermark
identifying a financial institution for an account on which the check is
issued
- Responsive to identifying the digital watermark in the image, determining
whether the overlaid digital watermark is authentic by comparing the
overlaid digital watermark identified in the image of the check to a
watermark associated with the financial institution for the account on

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which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs; and

- Responsive to the digital watermark being authentic, providing financial services to the customer

Rhoads discloses a method of producing a security document wherein a check (security document) is scanned (see abstract or paragraph 0019) to create an image of the check (see "photocopied" paragraph 0019); Searching the image of the check for an overlaid digital watermark identifying a financial institution for an account on which the check is issued (end of 0019 or FIG 12 "watermark detector"); Responsive to identifying the digital watermark in the image, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs; (0019) and; Responsive to the digital watermark being authentic, providing the financial services to the customer (see passport example in paragraph 0019; applicable to a bank customer and their account information).

It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Rhoads to that of Stinson in order to provide additional security measures to the check, including discouraging counterfeiting, transferring information through the documents without alerting human viewers to the presence of the information (Rhoads, paragraph 0008), or identifying a financial institution linked to the document (Rhoads, paragraph 0019).

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Re Claim 19: Further data processing system would have been necessary to perform previously rejected method claim 7 and is therefore rejected using the same art and rationale.

Re Claim 31: Further data processing system would have been necessary to perform previously rejected method claim 7 and is therefore rejected using the same art and rationale.

Re Claim 43: Further computer program product would have been necessary to run previously rejected method claim 7 and is therefore rejected using the same art and rationale.

Claims 9-10, 21-22, 33-34 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Rhoads as applied to claim 7 above, and further in view of Anderson.

Re Claim 9: Stinson in view of Rhoads discloses the claimed method supra but does not explicitly disclose the step of providing financial services to the customer comprises determining whether funds are available in the account on which the check is issued to cover an amount of the check. Anderson discloses such a step (Column 24, lines 28-36) and it would have been obvious to anyone of ordinary skill to include this step to the teaching of Stinson and Rhoads so that an issued check does not bounce because of insufficient funds. This is an old and well known step in banking and helps to eliminate future problems concerning inadvertent overdrafts of funds or potential fraud.

Re Claim 10: Stinson in view of Rhoads and further in view of Anderson discloses the claimed method supra and Anderson further discloses the step of initiating a funds transfer for the amount of the check in response to a determination that funds are available to cover the amount of the check (Column 24, lines 31-37).

Re Claims 21-22: Further data processing system would have been necessary to perform previously rejected method claims 9 and 10 respectively and are therefore rejected using the same art and rationale.

Re Claims 33-34: Further data processing system would have been necessary to perform previously rejected method claims 9 and 10 respectively and are therefore rejected using the same art and rationale.

Re Claims 45-46: Further computer program product would have been necessary to run previously rejected method claims 9 and 10 respectively and are therefore rejected using the same art and rationale.

Claims 11-12, 23-24, 35-36 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Lemelson (US Pat No 4,991,205) in view of Cuervo (US PAT 6,105,009).

Re Claim 11: Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising

- Verifying an identification of the user (Column 1 line 67- Column 2 line 2)

- Responsive to the identification of the user being verified, capturing an image of the user and retrieving user information associated with the user (Column 2, lines 14-34)

Stinson does not explicitly disclose the steps wherein this information is stored on an identification card and this card is generated at the automatic teller machine.

Lemelson discloses a personal identification system and method wherein one object is to "provide a credit card recording and reproduction system for rapidly and easily recording signals relating to a physical characteristic of the card owner on the card which recording may be reproduced by specialized equipment and employed to generate images of the face and signature of the card owner. (Column 1, line 65-Column 2, line 2)" It would have been obvious to someone skilled in the ordinary art at the time of invention to include the identification card taught by Lemelson to the biometrics verification method of Stinson so that a large central database of names does not need to be kept and referenced every time a person uses an ATM. If the data is stored on an individual card, provided by the user, then the system need only to read the information on the card, therefore saving memory space and money.

Stinson and Lemelson do not explicitly disclose the step of generating the identification card, however Cuervo discloses an automated teller machine dispenser of debit cards that discloses such a step including recording information about a customer and creating and dispensing the card (Fig 1 Ref 20; and Fig 2). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include this step to the disclosure of Stinson and Lemelson so that someone using an ATM for the first

time could have an identification card produced for them for future visits so they do not have to waste time in proceeding through a long verification process for each subsequent visit. Producing the card at the ATM vestibule is advantageous as well as a customer can simply perform this action once before their initial transaction as opposed to having to go out of the way to a central office to have a card generated.

Re Claim 12: Stinson in view of Lemelson in view of Cuervo discloses the claimed method supra and Cuervo further discloses dispensing the identification card to the user (Fig 1, ref 24).

Re Claims 23 and 24: Further data processing system would have been necessary to perform previously rejected method claims 11 and 12 respectively and are therefore rejected using the same art and rationale.

Re Claims 35 and 36: Further data processing system would have been necessary to perform previously rejected method claims 11-12 respectively and are therefore rejected using the same art and rationale.

Re Claims 47 and 48: Further computer program product would have been necessary to run previously rejected method claims 11 and 12 respectively and are therefore rejected using the same art and rationale.

Response to Arguments


Applicant's arguments with respect to claims 1-3, 5-7, 9-15, 17-19, 21-27, 29-31, 33-39, 41-43, and 45-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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